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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,046	09/09/2003	George William Muncaster	PF01874NA C01	1961

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EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/658,046

Applicant(s)

MUNCASTER ET AL.

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9 - 11, 13 - 22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 9 - 11, 13 - 22 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 22 and 24 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure but not included in the claim(s). Applicant has not claimed how the information which is transmitted to the receiver is received in to the electronic wireless lock box which is critical or essential to the practice of the invention, but not included in the claim(s). See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. For example, it is not clearly claimed whether the electronic lock box is a unit holding the information, or, it is a bridge to acquire the information from a central site and transmit to the receiver.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 – 11, 13 – 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al. US Patent 4,766,746 in view of Deighton et al. US Patent 5,791,172, and further in view of Piatek et al. US Patent 5,793,882.

Regarding claim 9, Henderson teaches an electronic lockbox corresponding to a real estate property. Henderson does not teach lockbox having a wireless communication. However, Deighton teaches electronic lockbox with wireless communication [Deighton Fig. 1 and description for Fig. 1 in the specification].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henderson as taught by Deighton to make the lockbox easy to use.

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Henderson in view of Deighton does not teach wirelessly communicating information about the real estate property. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide what information is transmitted between the devices. Piatek teaches information that may be stored in a block of machine-readable data located in a nearby lockbox or that may be remotely transmitted to information receiver 39 or some other receiver used with the system from a location associated with the site (step 111) [Piatek col. 8, lines 16 – 20].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henderson in view of Deighton as taught by Piatek to enable the devices to exchange business desired information with minimum interaction with the central server.

Henderson in view of Deighton and Piatek teaches controlling access to the real estate property.

Regarding claim 10, Henderson in view of Deighton and Piatek teaches electronic lock box is hermetically sealed [Fig. 1 (12)].

Regarding claim 11, as responded to earlier in response to claim 9, Henderson in view of Deighton and Piatek teaches electronic lock box is capable of receiving requests and transmitting information about the real estate property to a transmitting/receiving

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device located within a predetermined proximity of the electronic lock box (limitation of the range of wireless communication).

Regarding claim 13, Henderson in view of Deighton and Piatek does not explicitly teach information about the real estate property includes at least one of the group comprising a price of the real estate property, a square footage of the real estate property, a virtual tour of the real estate property, a number of bedrooms within the real estate property and an availability of the real estate property. However, Henderson in view of Deighton and Piatek teaches transmission of information from transmitter to receiver. Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to elect what information needs to be transmitted to the receiver to meet business requirements.

Regarding claim 14, Henderson in view of Deighton and Piatek teaches electronic lock box is capable of holding at least one key therein (With reference to FIGS. 2-3, lockbox 12 includes a secure enclosure, or house key compartment 20 designed to contain house keys, business cards, written messages and the like) [col. 3, lines 45 – 47].

Regarding claim 15, as responded to earlier in response to claims 9, 11 and 13, Henderson in view of Deighton and Piatek teaches transmitting/receiving device is one of a client configured device and a controlling agent device, the client configured device

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capable of requesting information about the real estate property from the electronic lock box [Piatek col. 8, lines 16 – 20], transmitting queries about the real estate property to the electronic lock box (obvious that the query is transmitted from initiating unit to the serving unit), transmitting client information to the electronic lock box (e.g. key serial number), transmitting client information to a remote real estate office via the electronic lock box [Piatek Fig. 13 and description for the figure in the specification], viewing information received from either the electronic lock box or recording voice or text messages in the electronic lock box [Piatek claim 1].

Regarding claim 16, as responded to earlier in response to claims 9, 11, 13 and 15, Henderson in view of Deighton and Piatek teaches the controlling agent device is capable of performing all client configured device functions (design choice) and is further capable of at least enabling, programming and disabling the electronic lock box (e.g. opening the lockbox), overriding access restrictions of the electronic lock box, viewing information stored by the real estate sign and the electronic lock box, downloading information stored by the electronic lock box, interacting with other premises electronic equipment, and maintaining the electronic lock box.

Regarding claim 17, Henderson in view of Deighton and Piatek teaches electronic lock box consisting of a memory [Fig. 9].

Regarding claim 18, Henderson in view of Deighton and Piatek teaches electronic lock box is capable of storing a time of a visit to the real estate property (access log maintained in the lockbox) [col. 2, line 29].

Regarding claim 19, Henderson in view of Deighton and Piatek teaches electronic lock box can communicate via network to a controlling real estate office box (design choice and business choice) [Piatek Fig. 13 and description for the figure in the specification], the controlling real estate office transmitting a control signal to the electronic lock box to permit access to the real estate property (design choice).

Regarding claim 20, Henderson in view of Deighton and Piatek teaches electronic lock box is capable of recording an attempt to gain access to the real estate property [col. 2, line 29].

Regarding claim 21, Henderson in view of Deighton and Piatek teaches electronic lock box can restrict access to the real estate property based upon communicated entry rules (design choice, business choice, e.g. no one can access the property after 9:00 pm).

Regarding claim 22, Henderson teaches an electronic lockbox corresponding to a real estate property. Henderson does not teach lockbox having a an electronic lock box having a wireless communication system embedded therein. However, Deighton



teaches electronic lockbox with wireless communication [Deighton Fig. 1 and description for Fig. 1 in the specification].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henderson as taught by Deighton to make the lockbox easy to use.

Henderson in view of Deighton does not teach electronic lock box located within a predetermined distance from a real estate property and controlling access to real estate property. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to locate electronic lock box within a predetermined distance from a real estate property and controlling access to real estate property to help the agent locate the lock box to gain access to the property.

Henderson in view of Deighton does not teach a transmitting/receiving device, wherein the transmitting receiving device can transmit information to/from the electronic lock box about the real estate property. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide what information is transmitted between the devices. Piatek teaches information that may be stored in a block of machine-readable data located in a nearby lockbox or that may be remotely transmitted to information receiver 39 or some other receiver used with the system from a location associated with the site (step 111) [Piatek col. 8, lines 16 – 20].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henderson in view of Deighton as taught by

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Piatek to enable the devices to exchange business desired information with minimum interaction with the central server.

Henderson in view of Deighton and Piatek teaches controlling access to the real estate property.

Regarding claim 24, Henderson teaches marketing a real estate property . Henderson teaches providing an electronic lock box. Henderson does not teach electronic lock box having a wireless communication system embedded therein (invention not claimed by the applicant in this claim). However, Deighton teaches electronic lockbox with wireless communication [Deighton Fig. 1 and description for Fig. 1 in the specification].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henderson as taught by Deighton to make the lockbox easy to use.

Henderson in view of Deighton does not teach electronic lock box located within a predetermined distance from a real estate property and controlling access to real estate property. Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to locate electronic lock box within a predetermined distance from a real estate property and controlling access to real estate property to help the agent locate the lock box to gain access to the property.

Henderson in view of Deighton teaches receiving, by the electronic lock box, queries about the real estate property from a transmitting/receiving device;

Henderson in view of Deighton does not teach transmitting information about the real estate property from the electronic lock box to the transmitting/receiving device. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide what information is transmitted between the devices. Piatek teaches information that may be stored in a block of machine-readable data located in a nearby lockbox or that may be remotely transmitted to information receiver 39 or some other receiver used with the system from a location associated with the site (step 111) [Piatek col. 8, lines 16 – 20].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henderson in view of Deighton as taught by Piatek to enable the devices to exchange business desired information with minimum interaction with the central server.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Harold et al. US Patent 6,472,973
2. Imran US Patent 4,400,255

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Naresh Vig", with a stylized flourish at the end.

Naresh Vig  
Patent Examiner  
January 7, 2005